

REMARKS

The Office Action mailed November 14, 2006, has been received and reviewed. Claims 2-11 are pending in the application. Claims 2, 5, 6, 9 and 10 were previously withdrawn from consideration. Claims 3, 4, 7, 8 and 11 stand rejected. Claim 3 is amended herein. All amendments are made without prejudice or disclaimer. Reconsideration is requested.

35 U.S.C. §102(b)

Claims 3, 4, and 8 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Weld et al. (2002, *Plant Cell, Tissue and Organ Culture* 69:45-54). Applicants respectfully traverse the rejection as set forth herein.

It was asserted that Weld et al. teaches a T-DNA construct carrying the Ac transposase gene was transferred to *Hieracium aurantiacum* (A3 3621) leaf discs by co-cultivation with *Agrobacterium tumefaciens*. Claim 3 as amended herein recites “A method for transposing a transposon that does not have a transposase, wherein the method comprises the steps of: using *Agrobacterium* to introduce an FLP-encoding DNA into a transformed plant that comprises the transposon having no transposase, and transiently expressing the transposase.” Support for the amendment may be found throughout the as-filed specification, for example, paragraph [0021] and paragraphs [0043]-[0045]. Weld et al. does not describe, either expressly or inherently, every element of the claimed invention.

Claim 3 as amended recites in part “using *Agrobacterium* to introduce an FLP-encoding DNA into a transformed plant that comprises the transposon having no transposase, and transiently expressing the transposase.” FLP is a yeast-derived recombinase that recognizes FLP recombinase target (FRT) sequences which flank a region of interest. By contrast, Weld et al. discloses a maize Ac/Ds binary system, in which the mobilization of a Ds element requires the presence of an Ac element. Although Weld et al. describes using *Agrobacterium* for transient gene expression, the genes which undergo transient expression (Ac element for Weld et al. and FLP for the present invention) are different. As Weld et al. fails to describe either expressly or inherently, every element of the claimed invention, Weld et al. cannot anticipate the presently claimed invention. Reconsideration and withdrawal of the rejection is requested.

Dependent claims 4 and 8 are allowable, as least, for the same reasons as stated for claim 3.

35 U.S.C. §103(c)

Claims 7 and 11 stand rejected under 35 U.S.C. §103(c) as being unpatentable over Weld et al. (2002, *Plant Cell, Tissue and Organ Culture* 69:45-54). Applicants respectfully traverse the rejection as set forth herein.

The Court of Appeals for the Federal Circuit has stated that “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). See also MPEP § 2143.03. Having failed to teach or suggest each and every limitation of the current application, the prior art referenced as rendering dependent claims 7 and 11 obvious, cannot serve as a basis for rejection.

Respectfully submitted,



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